

### **REMARKS**

Applicant traverses the rejection by the Examiner and respectfully requests reconsideration. Applicant submits that the claims are now in condition for allowance and respectfully requests reconsideration.

#### **I. CLAIMS 1-6 and 8-10 ARE NOT OBVIOUS IN VIEW OF THE CITED REFERENCES**

The Examiner has rejected claims 1-6 and 8-10 under 35 U.S.C. § 103 for obviousness in the instant Office Action. The Examiner alleges to have met all criteria necessary to construct a *prima facie* case of obviousness. Applicant disagrees.

To establish a *prima facie* case of obviousness, four basic criteria must be met. First, a prior art reference must be analogous art. Second, from the prior analogous art, there must be a suggestion or motivation in the prior art to modify or combine reference teachings. Third, there must be a reasonable expectation of success in modifying or combining reference teachings. Finally, the combined prior art references must teach or suggest all claim limitations. *See* MPEP § 706.02(j). *See King Instrument Corp. v. Otari Corp.*, 767 F.2d 853 (Fed. Cir. 1985). *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

#### **1. Claims 1-6 and 8-10 are not obvious over Nakamura et al. (WO 95/11542) in view of Braun et al. (US 5,277,459)**

The Examiner has rejected claims 1-6 and 8-10 for obviousness over Nakamura et al. (WO 95/11542) in view of Braun et al. (US 5,277,459). Applicant disagrees for the following reasons.

##### **A. The Examiner is required to undertake a "rigorous" burden of proof**

"The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is *rigorous* application of the requirement for a specific showing of the

teaching or motivation to combine prior art references.” *See* MPEP. *See In re Dembiczak*, 175 F.3d at 999 (Fed. Cir. 1999) (emphasis added).

Implementation of this burden obligates the Examiner to make specific and particularized findings in the prior art or otherwise that would properly motivate a modification of the cited art. The Examiner “must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.” *See* MPEP. *See, e.g., In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (emphasis added). The Examiner must “rely on objective evidence and must make specific factual findings with respect to the motivation to combine references.” *See* MPEP § 2143.01. *See In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (emphasis added).

In this case, the Examiner has given no substantive factual evidence or analysis of motivation to combine (such as, for example, admissions or failings within the cited art) in support of the Examiner's otherwise conclusory assertions of obviousness. In particular, after stating generally what each reference discloses in the Office Action, the Examiner follows by merely stating that such a combination is “obvious” with nothing more than a conclusory reconstruction or assemblage of Applicant's claimed features piece-by-piece—this is classic evidence of improper hindsight reasoning by the Examiner.

Applicant respectfully submits that the Examiner's analysis does not meet the aforementioned “rigorous” burden of proof.

B. There is no substantive suggestion or motivation to combine Nakamura et al. with Braun et al.

In order to modify or combine the cited references, the Examiner is required to provide a suggestion or motivation within the prior art to modify or combine reference teachings, from which there must also be a reasonable expectation of success. The law is undeniably clear that “in order to prevent a hindsight-based obviousness analysis, there must be a *reason, suggestion, or motivation in the prior art*,” thereby preventing one of ordinary skill in the art from exploiting

hindsight when combining references. *See Ruiz v. A.B. Chance Co.*, 234 F3d 654 (Fed. Cir. 2000) (emphasis added). Both the suggestion or motivation and the reasonable expectation of success "*must be found in the prior art* and not based on Applicant's disclosure." MPEP § 706.02(j). MPEP § 2143.01. (emphasis added) The mere fact that the prior art may be modified in the manner suggested by the Examiner "does not make the modification obvious *unless the prior art suggested the desirability of the modification.*" MPEP § 706.02(j). MPEP § 2143.01 *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992) (emphasis added).

Braun generally teaches a pipe hinge. However, the Examiner's awkward combination of Braun with Nakamura is revealed as Braun actually conflicts with the present invention. Further, as respectfully submitted, *infra*, Braun not only conflicts with the present invention—it actually *teaches away* from the present invention.

Nakamura teaches a removable core which includes a slip member having a low friction interposed between the inner periphery of an elastic covering member and the outer periphery of the core. When the slip member and the core are connected with each other in an end-to-end manner, the slip member can be pulled out together with the core. In this manner, the final resultant product that is produced from pulling the core and the slip member is a cable or other such device covered by an elastic covering member. In other words, the core and slip member are not used in the industrial application of the final resultant product. In Nakamura, the core is a single unitary member and does not have a joint portion connection two plate-like portions.

As the Examiner notes in the Office Action, Braun discloses a hinge generally, as understood by those skilled in the art. However, the Examiner fails to consider that even when mentioning the hinge connecting portions of pipe, Braun makes no teaching or suggestion regarding disposing the hinged pipe between a cold shrink elastic covering member and a cable, nor does it teach or suggest pulling the hinged pipe from between a cold shrink elastic covering member and a cable, nor does it teach or suggest completely removing the hinged pipe from the final resultant product of a cable sealed with an elastic covering member, as specifically taught in Nakamura. In fact, the hinged pipe is the final resultant product in Braun—not even remotely similar to a pull-out tool for use in cold-shrink applications as in Nakamura. Nowhere does Braun even slightly teach or suggest utilizing the disclosed hinged plate-like pipe within the

context of a removable plate-like core for cold shrink elastic covering applications. Therefore, absent a hindsight assessment of Applicant's claimed invention, a person of ordinary skill in the art would not have sought out Braun for the purpose of a combination with Nakamura, because neither Braun nor Nakamura teach or suggest such a motivation. Therefore, clearly there is no motivation explicitly nor implicitly within the references to combine the reference teachings based on what each discloses as a whole.

Furthermore, Nakamura's disclosure demonstrates that Braun actually *teaches away* from any such combination. A combination reference teaches away from the primary reference if its combination renders the primary reference unsatisfactory for its intended purpose or changes the principle of operation of the primary reference. See MPEP § 2145 Section X.D.; MPEP § 2141.02 Section VI; MPEP § 2143.01 Sections V-VI. The foundational principle of operation of Nakamura is to 1) dispose a core and a slippery section inside an elastic covering member to hold the elastic covering member in an expanded state, and 2) remove the core together with the slippery section from contact with the elastic covering member. The intended purpose of the core in Nakamura is to hold the elastic covering member in an expanded state, and thereby effectuate tightening of the elastic covering member around a cable after removing the core from contact with the elastic covering member. The inclusion of the pipe connector of Braun into the elastic covering member of Nakamura is problematic because pipe connectors are not designed to function as cores that hold an elastic covering member in an expanded state, nor are pipe connectors designed in such a way to be removed from an elastic covering member after holding the elastic covering member in an expanded state. Furthermore, the inclusion of the pipe connector of Braun into the elastic covering member of Nakamura would essentially render Nakamura inoperable and unworkable because the pipe connector has no "slippery section" structure or other characteristic that might allow the pipe connector to be removed from a position holding the elastic covering member in an expanded state. In summary, pipe connectors are not even remotely operable as removable cores in cold shrink articles. Therefore, any attempt at combining Braun with Nakamura would change Nakamura's principle of operation and clearly render Nakamura unsatisfactory and/or nonfunctional for its intended purpose of providing a

slippery removable core for cold shrink applications. For this reason, Applicant respectfully disagrees with the Examiner's conclusion.

With all respect to the Examiner, there are absolutely no express or implied admissions or failings in the cited references that provide a compelling motivation that that the cited art must somehow be modified, changed, fixed, or improved upon, and especially none relating to the modifications asserted by the Examiner. It is clear that the Examiner has combined references to reconstruct Applicant's claimed invention by utilizing improper piece-by-piece hindsight reasoning after using Applicant's claimed invention as a roadmap, which is prohibited by MPEP § 706.02(j) and MPEP § 2143.01.

For these reasons, Applicant respectfully reminds the Examiner to resist the temptation of hindsight to use Applicant's invention as a roadmap in combining the cited references in a piece-by-piece hindsight manner.

**CONCLUSION**

In view of the remarks set forth herein, Applicant respectfully requests reconsideration of the application. Applicant respectfully submits that the application is in condition for allowance, and requests that a Notice of Allowance be issued in due course.

The Commissioner is hereby authorized to charge all fees due and any additional fees that may be required or credit any overpayment to Deposit Account Number 13-3723.

Respectfully submitted,

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12/7/06  
Date

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